

ESTTA Tracking number: **ESTTA566090**Filing date: **10/21/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Perine International Inc.
Granted to Date of previous extension	10/23/2013
Address	Room 908-910, Wing On Plaza 62 Mody Road, Tsim Sha Tsui East Kowloon, HONG KONG
Attorney information	Jeffrey Schreiber Meister Seelig & Fein LLP 140 East 45th Street, 19th Floor New York, NY 10017 UNITED STATES js@msf-law.com,kaf@msf-law.com,sms@msf-law.com Phone:212-655-3500

Applicant Information

Application No	85917605	Publication date	06/25/2013
Opposition Filing Date	10/21/2013	Opposition Period Ends	10/23/2013
Applicant	Seena International, Inc. 1140 Motor Parkway Hauppauge, NY 11788 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2005/10/31 First Use In Commerce: 2005/10/31

All goods and services in the class are opposed, namely: Hoodies; Tops; Pants; Jackets; Coats; all of the foregoing not to be used in connection with restaurants or restaurant services

Grounds for Opposition

The mark is primarily geographically deceptively misdescriptive	Trademark Act section 2(e)(3)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Doctrine of issue or claim preclusion
Related Proceedings	Perine International Inc. v. Bedford Clothiers, Inc. et al., Index No. 650040/12, Supreme Court of the State of New York
Attachments	Notice of Opposition 102113.pdf(758691 bytes)

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Susan M. Schlesinger/
Name	Susan M. Schlesinger
Date	10/21/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 85/917,605
Published in the *Official Gazette* on June 25, 2013

-----X	X	
Perine International Inc.	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No.:
	:	
	:	
Seena International Inc.,	:	
Applicant.	:	
-----X	X	

NOTICE OF OPPOSITION

Perine International Inc. (“Perine” or “Opposer”) believes that it will be damaged by registration of the mark shown in U.S. Trademark Application Serial Number 85/917,605 and hereby opposes same. The grounds for the opposition are as follows:

COUNT I

1. Opposer is a corporation organized and existing under the laws of the British Virgin Islands having an address at Room 908-910, Wing On Plaza, 62 Mody Road, Tsim Sha Tsui East, Kowloon, Hong Kong.

2. Seena International, Inc. (“Applicant”) is a New York corporation having an address at 1140 Motor Parkway, Hauppauge, New York 11788.

3. Opposer is a manufacturer and purveyor of clothing and manufactures clothing for, and sells clothing to, Applicant. In 2012, Opposer filed a lawsuit against Applicant and other related entities for several causes of action including breach of contract and fraud. The lawsuit was filed in the Supreme Court of the State of New York, County of New York, *Perine*

International Inc. v. Bedford Clothiers, Inc. et al., Index No. 650040/12 (the “New York Action”). The New York Action is still pending.

4. Applicant subsequently filed an application pursuant to Section 1(a) of the Trademark Act for registration of the DITCH PLAINS trademark for “hoodies, tops, pants, jackets, coats all of the foregoing not to be used in connection with restaurants or restaurant services” in Class 25. The application was issued U.S. Trademark Application Serial Number 85/917,605 (the “‘605 Application”).

5. Applicant’s filing of the ‘605 Application coincided with Applicant’s filing of counterclaims against Opposer in the New York Action for, *inter alia*, common law trademark infringement and unfair competition. Applicant alleges in the New York Action that Opposer sold unauthorized goods in connection with the DITCH PLAINS trademark and that Opposer infringed the DITCH PLAINS trademark by the sale of such goods.

6. As part of the basis for the filing of its counterclaims in the New York Action, Applicant asserted the filing of the ‘605 Application in the Trademark Office. Indeed, as shown in the prosecution history of the ‘605 Application, Applicant filed a Petition to Make Special requesting that the Trademark Office review the ‘605 Application on an expedited basis in view of the New York Action and other anticipated “additional litigations” so that Applicant could assert a federal registration for the DITCH PLAINS trademark against Opposer, as well as its alleged common law rights.

7. The ‘605 Application should be denied registration inasmuch as, upon information and belief, Applicant has committed a fraud on the Trademark Office regarding the date of first use claimed for the DITCH PLAINS trademark.

8. In the ‘605 Application, Applicant has claimed a date of first use of the DITCH PLAINS trademark in connection with the goods as of October 31, 2005.

9. Yet, prior to filing the ‘605 Application, Applicant previously filed two applications (which were abandoned) to register DITCH PLAINS as a trademark claiming a date of first use of July 17, 2007. U.S. Trademark Application Serial No. 76/694,609 was filed on December 3, 2008 for DITCH PLAINS as a word mark for “men’s and women’s clothing, namely suits, trousers, jackets, blouses, pants, dresses, shirts, shorts, board shorts, underwear, jeans, t-shirts, hats, vests, sweatshirts, ties, tanktops, coats, hats, and swim trunks” in Class 25 (the “‘609 Application”) (emphasis added). U.S. Trademark Application Serial No. 77/947,996 was filed on March 2, 2010 for the DITCH PLAINS and Surfboard Design trademark for “Men's and Women's clothing, namely suits, trousers, jackets, blouses, pants, dresses, shirts, shorts, board shorts, underwear, jeans, t-shirts, hats, vests, sweatshirts, ties, tank tops, coats, hats and swim trunks” in Class 25 (the “‘996 Application”) (emphasis added). Attached as Exhibit A are true and correct copies of printouts from the Trademark Office’s TSDR database showing the claimed date of first use for the ‘609 and ‘996 Applications.

10. Notably, Applicant’s DITCH PLAINS trademark and the goods covered under the prior applications and Applicant’s goods covered under the ‘605 Application are the same, albeit with a couple of different inconsequential word choices, “hoodie” instead of “sweatshirt” and “tops” instead of “shirts” or “t-shirts,” but “pants,” “jackets” and “coats” are exactly the same. Despite Applicant applying for the same word mark and for the same goods, the ‘605 Application claims a date of first use of the DITCH PLAINS mark as of October 31, 2005. Such date is nearly **two years earlier** than the date of first use previously claimed for the DITCH PLAINS mark of July 17, 2007 for the same goods as in the prior applications.

11. Applicant had also asserted 2007 as the date of first use of the DITCH PLAINS trademark in the responsive pleading it presented and proposed to file in the New York Action along with a motion to amend its pleading. Attached as Exhibit B are true and correct copies of the relevant pages from Applicant's verified responsive pleading in the New York Action showing the allegation of 2007 as the date of first use of the trademark. Curiously, after Opposer objected to Applicant's motion to amend, Applicant changed the date of first use asserted for the DITCH PLAINS trademark on its pleading to coincide with the date it claimed on the '605 Application. Attached as Exhibit C are true and correct copies of the relevant pages from Applicant's second verified responsive pleading in the New York Action showing the allegation in which the date was changed from 2007 to October 31, 2005. Notably, up until Applicant sought to file its new application for the DITCH PLAINS trademark, Applicant had consistently maintained that the date of first use of the DITCH PLAINS mark was 2007.

12. Upon information and belief, Applicant knew that claiming October 31, 2005 as the date of first use of the DITCH PLAINS trademark on the '605 Application was false where Applicant not only asserted 2007 as the date of first use of the DITCH PLAINS trademark on two prior applications years ago, but had also recently asserted 2007 as the date of first use of the DITCH PLAINS trademark in a court pleading in the New York Action until it filed the '605 Application.

13. Registration of the '605 Application should be denied based on Applicant's misrepresentation as to the date of first use of its DITCH PLAINS trademark to the Trademark Office.

COUNT II

14. Opposer repeats and realleges paragraphs 1 through 13 as though fully set forth herein.

15. The '605 Application should be denied registration because the DITCH PLAINS trademark when used in connection with Applicant's goods is primarily geographically deceptively misdescriptive in violation of Section 2(e)(3) of the Trademark Act.

16. The primary significance of Applicant's DITCH PLAINS trademark is that it is a generally known geographic location.

17. "Ditch Plains" is a well-known beach area of Montauk, New York, which is widely recognized as a popular surfing destination.

18. Applicant is not located in Ditch Plains. Applicant's address of record with the Trademark Office shows that Applicant is not located in Montauk, New York, let alone the Ditch Plains area of Montauk.

19. Though Applicant is not located in Ditch Plains, New York, the specimen showing use of the DITCH PLAINS trademark Applicant submitted to the Trademark Office for the '605 Application ("Applicant's Specimen"), prominently displays DITCH PLAINS NEW YORK on the label on Applicant's goods.

20. Applicant's Specimen also shows "EST. 1970" which gives the impression that Applicant has been in Ditch Plains, New York since 1970. This is misleading inasmuch as Applicant is not even located in Ditch Plains, let alone having been established there since 1970.

21. As also shown in Applicant's Specimen, Applicant's shirt is in the style of clothing popular among surf enthusiasts.

22. Between the label on Applicant's goods and Applicant's style of clothing, Applicant is clearly making an association to the Ditch Plains beach area of Montauk, New York, even though Applicant is not located there.

23. Applicant's Specimen also shows that the goods are manufactured in China and not in the Ditch Plains area of Montauk, New York.

24. Based on Applicant's address of record with the Trademark Office and the manufacturing label on Applicant's goods, neither Applicant nor Applicant's goods originate from the Ditch Plains area of Montauk, New York.

25. Consumers seeing Applicant's surf-inspired goods bearing a label that prominently displays DITCH PLAINS NEW YORK would likely believe that Applicant's goods originate from the Ditch Plains area of New York. Even if consumers see the manufacturing label on Applicant's goods, they would likely think that some manufacturing may be done in China on behalf of Applicant, but that Applicant is part of the Ditch Plains community (since 1970) and, therefore, so are Applicant's goods.

26. The misleading connection of Applicant and its goods to the Ditch Plains area of Montauk, New York is further evidenced by the design of a surfer on a surf board which is displayed on the Chinese manufacturing label as shown on Applicant's Specimen.

27. The misleading connection of Applicant and its goods to the Ditch Plains area of Montauk, New York is also demonstrated by Applicant's use of a hang tag for its goods which is in the shape of a surfboard that prominently displays the DITCH PLAINS trademark in connection with "MONTAUK, NEW YORK." Attached as Exhibit D is a true and correct copy of such hang tag from Applicant's goods.

28. Since Ditch Plains is widely known as a popular beach area and surfing destination, consumers seeing the DITCH PLAINS trademark on and/or in connection with Applicant's goods will think that they are getting authentic beach and surf clothing which emanates from the Ditch Plains area of Montauk, New York. The fact that neither Applicant nor its goods are from Ditch Plains constitutes a misrepresentation that would be a material factor to a consumer's decision to purchase the goods.

29. Registration of the '605 Application should be denied inasmuch as DITCH PLAINS is geographically deceptively misdescriptive in connection with Applicant's goods.

COUNT III

30. Opposer repeats and realleges paragraphs 1 through 29 as though fully set forth herein.

31. Applicant should be precluded from registering the '605 Application based on a prior decision of the Trademark Trial and Appeal Board (the "Board") refusing to register the DITCH PLAINS trademark of Applicant.

32. Applicant previously sought to register DITCH PLAINS as a trademark and filed the '609 Application. The '609 Application was refused registration by the Examining Attorney due to a likelihood of confusion in view of a prior registered trademark for DITCH PLAINS, U.S. Registration No. 3,327,160.

33. After receiving the Examining Attorney's final refusal to register the '609 Application for a likelihood of confusion with U.S. Registration No. 3,327,160, Applicant filed an appeal to the Board in an attempt to overcome the likelihood of confusion refusal.

34. While the appeal to the Board was pending, Applicant brazenly sought to register the DITCH PLAINS and Surfboard Design trademark and filed the '996 Application. The '996 Application was also refused registration by the Examining Attorney due to a likelihood of confusion in view of U.S. Registration No. 3,327,160.

35. On appeal, the Board issued its decision affirming the Examining Attorney's refusal to register the '609 Application based on a likelihood of confusion with U.S. Registration No. 3,327,160 (the "Board's Decision"). Attached as Exhibit E is a true and correct copy of the Board's Decision.

36. Applicant subsequently filed an appeal of the Board's Decision with the Federal Circuit, but the appeal was ultimately dismissed. Attached as Exhibit F is a true and correct copy of the Federal Circuit's Order dismissing the appeal.

37. After dismissal of the Federal Circuit appeal, a Notice of Abandonment issued for the '609 Application due to the Board's Decision affirming the refusal to register the DITCH PLAINS trademark of Applicant.

38. The refusal to register the '996 Application based on a likelihood of confusion with U.S. Registration No. 3,327,160 was maintained during the pendency of the appeal to the Federal Circuit and further action on the '996 Application was suspended pending the outcome of the appeal to the Federal Circuit. The '996 Application was subsequently deemed abandoned for a failure to respond to the Examining Attorney about the appeal. It is clear that the refusal to register would have been maintained and final had Applicant not filed the appeal of the Board's Decision.

39. Under the doctrine of issue or claim preclusion, Applicant should be denied registration of the '605 Application where Applicant has already been refused registration of the DITCH PLAINS trademark and such refusal was fully considered and affirmed by the Board and not reversed on appeal to the Federal Circuit. The Board's Decision refusing registration of the DITCH PLAINS trademark to Applicant is, therefore, in effect and should serve to preclude registration of the '605 Application.

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that Applicant's application to register DITCH PLAINS as a trademark be denied in all respects.

Dated: October 21, 2013

Respectfully Submitted,

/Susan M. Schlesinger/
Jeffrey Schreiber
Kevin A. Fritz
Susan M. Schlesinger
MEISTER SEELIG & FEIN LLP
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New York, NY 10017
Telephone: 212-655-3500
Fax: 212-655-3535
E-mail: js@msf-law.com
kaf@msf-law.com
sms@msf-law.com
Attorneys for Opposer

CERTIFICATE OF SERVICE AND FILING

The undersigned hereby certifies that a copy of the foregoing Notice of Opposition was served on the Applicant on the date indicated below by depositing the same with the United States Postal Service, First Class Mail, postage pre-paid, to Applicant's correspondent address of record:

Martin J. Feinberg, Esq.
Olshan Frome Wolosky LLP
65 E. 55th Street
New York, NY 10022-3219

and to counsel for Applicant in the New York Action:

Lynne M. Fischman Uniman, Esq.
Andrews Kurth LLP
450 Lexington, 15th Floor
New York, NY 10017

and further certifies that the aforementioned Notice of Opposition was filed with the Trademark Trial and Appeal Board on the date indicated below online through the ESTTA system of the United States Patent and Trademark Office.

Dated: October 21, 2013

/Susan M. Schlesinger/
Susan M. Schlesinger

EXHIBIT A

STATUS DOCUMENTS

[Back to Search](#)

Print

Generated on: This page was generated by TSDR on 2013-10-17 14:12:35 EDT**Mark:** DITCH PLAINS**DITCH PLAINS****US Serial Number:** 76694609**Application Filing Date:** Dec. 03, 2008**Register:** Principal**Mark Type:** Trademark**Status:** Abandoned after an appeal of the examining attorney's final refusal. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.**Status Date:** Dec. 18, 2010**Date Abandoned:** Dec. 18, 2010

Mark Information

Mark Literal Elements: DITCH PLAINS**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: -Mens and Womens CLOTHING, NAMELY SUITS, TROUSERS, JACKETS, BLOUSES, PANTS, DRESSES, SHIRTS, SHORTS, BOARD SHORTS, UNDERWEAR, JEANS, T-SHIRTS, HATS, VESTS, SWEATSHIRTS, TIES, TANKTOPS, COATS, HATS, and SWIM TRUNKS**International Class(es):** 025 - Primary Class**U.S Class(es):** 022, 039**Class Status:** ACTIVE**Basis:** 1(a)**First Use:** Jul. 17, 2007**Use in Commerce:** Jul. 17, 2007

Basis Information (Case Level)

Current Owner(s) Information

Owner Name: Seena International Inc.**Owner Address:** 95 Horse Block Road, P.O. Box 60
Yaphank, NEW YORK 11980
UNITED STATES**Legal Entity Type:** CORPORATION**State or Country Where
Organized:** NEW YORK

Attorney/Correspondence Information

Prosecution History

TM Staff and Location Information

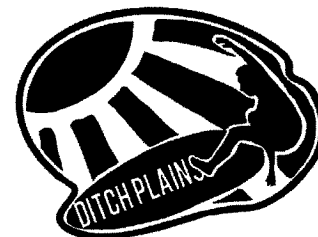
Assignment Abstract Of Title Information - Click to Load

Proceedings - Click to Load

STATUS DOCUMENTS

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Print

Generated on: This page was generated by TSDR on 2013-10-17 14:14:54 EDT**Mark:** DITCH PLAINS**US Serial Number:** 77947996**Application Filing Date:** Mar. 02, 2010**Register:** Principal**Mark Type:** Trademark**Status:** Abandoned because the applicant failed to respond or filed a late response to an Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.**Status Date:** Dec. 01, 2011**Date Abandoned:** Oct. 21, 2011

Mark Information

Mark Literal Elements: DITCH PLAINS**Standard Character Claim:** No**Mark Drawing Type:** 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)**Description of Mark:** The mark consists of the words "DITCH PLAINS" on a stylized surfboard ridden by a person in front of a backdrop comprised of a stylized sun design.**Color(s) Claimed:** Color is not claimed as a feature of the mark.**Design Search Code(s):** 01.05.25 - Sun, other representations of the sun
21.03.27 - Surfboards; Body boards; Snowboards

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Men's and Women's clothing, namely suits, trousers, jackets, blouses, pants, dresses, shirts, shorts, board shorts, underwear, jeans, t-shirts, hats, vests, sweatshirts, ties, tank tops, coats, hats and swim trunks**International Class(es):** 025 - Primary Class**U.S Class(es):** 022, 039**Class Status:** ACTIVE**Basis:** 1(a)**First Use:** Jul. 17, 2007**Use in Commerce:** Jul. 17, 2007

Basis Information (Case Level)

Current Owner(s) Information

Owner Name: Seena International Inc.**Owner Address:** P.O. Box 60
95 Horse Block Road
Yaphank, NEW YORK 11980
UNITED STATES**Legal Entity Type:** CORPORATION**State or Country Where** NEW YORK
Organized:

Attorney/Correspondence Information

Prosecution History

TM Staff and Location Information

Assignment Abstract Of Title Information - Click to Load

Proceedings - Click to Load

EXHIBIT B

SUPREME COURT OF THE STATE OF NEW YORK
COUNTY OF NEW YORK

PERINE INTERNATIONAL INC.,

Plaintiff,

- against -

BEDFORD CLOTHIERS, INC., SEENA
INTERNATIONAL INC., RICKY SINGH,
BROOKLYN XPRESS, and VASU
KOTHAPALLY,

Defendants,

-against-

REGENT ALLIANCE LTD., J & COMPANY
JEANS LLC, and NA LAM, also known as LINNA LAM,

Additional Cross-Claim Defendants.

Index No. 650040/12

Assigned to
Hon. Barbara
R. Kapnick J.S.C.

IAS Part 39

**AMENDED VERIFIED
ANSWER WITH
COUNTERCLAIMS AND
CROSS-CLAIMS**

Defendants Bedford Clothiers, Inc. ("Bedford"), Seena International Inc. ("Seena"), Ricky Singh ("Singh") and Brooklyn Xpress ("Xpress") (hereinafter collectively referred to as "Defendants")¹, by their attorneys, Olshan Frome Wolosky LLP, as and for their Amended Verified Answer and Counterclaims, state:

ANSWERING THE COMMON ALLEGATIONS

1. Deny each and every allegation set forth in paragraphs 1, 46 and 48 of the Verified Complaint.
2. Deny knowledge and information sufficient to form a belief as to each and every allegation set forth in paragraphs 2, 3 and 4 of the Verified Complaint.

¹ Defendant Vasu Kothapally filed a Voluntary Petition under Chapter 7 of the U.S. Bankruptcy Code in the United States Bankruptcy Court, Eastern District of New York on February 22, 2013. Accordingly, this proceeding is currently stayed as against Mr. Kothapally pursuant to 11 U.S.C. § 362.

AS AND FOR A FIFTH AFFIRMATIVE DEFENSE

19. Plaintiff's claims are barred to the extent of a setoff in the sum of \$59,680.01, for the goods that were accepted but not shipped as directed in its purchase orders, either because:

- (a) they were shipped early causing Defendant Bedford to incur storage and related costs and/or
- (b) they were shipped late, resulting in certain reductions as enumerated on the purchase orders.

AS AND FOR A SIXTH AFFIRMATIVE DEFENSE

20. Plaintiff lacks standing to pursue the claims set forth in the Verified Complaint as it is a foreign corporation doing business in New York, but is not registered as required under New York's Business Corporation Law.

AS AND FOR A SIXTH AFFIRMATIVE DEFENSE

21. Plaintiff's claims are barred for failure to name Regent Alliance LTD., a necessary party to this action.

COUNTERCLAIMS

Defendants Bedford and Seena (hereinafter Bedford and Seena are sometimes collectively referred to as "Counterclaim Plaintiffs"), by their attorneys Olshan Frome Wolosky LLP, for their counterclaims against Plaintiff Perine International Inc. ("Perine") and their cross-claims against Defendants Regent Alliance Ltd. ("Regent"), J & Company Jeans LLC ("J & Co.") and Na Lam, also known as Linna Lam ("Lam"), allege on knowledge as to their own acts and otherwise on information and belief as follows:

INTRODUCTION

22. Seena is engaged in the design, manufacture, distribution and sale of high quality apparel items, which are sold primarily in mid-tier department stores and discount retailers throughout the United States, Canada and Europe. Since at least 2007, Seena has designed, manufactured and sold apparel products bearing the DITCH PLAINS word mark; since at least

2010, Seena has also designed, manufactured and sold apparel products bearing the DITCH PLAINS logo. These DITCH PLAINS trademarks are well known to the consuming public and trade.

23. Bedford, acting as Seena's design and production arm, is engaged in the design, manufacture and distribution of the high quality apparel items requested by Seena bearing the DITCH PLAINS word mark, DITCH PLAINS logo and other trademarks and designs owned by Seena.

24. Defendant Lam and her husband, Moe Cohen, are the principals of Plaintiff Perine, and Defendants Regent and J & Co. (hereinafter sometimes collectively referred to as the "Perine Defendants"). The Perine Defendants operate companies out of Hong Kong who work with brands in the U.S. to have their apparel goods made in China.

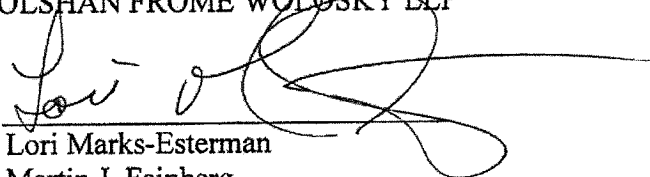
25. From December 2010 through December 2011, Bedford contracted with the Perine Defendants for the manufacture of Seena's apparel goods. From the very outset, Bedford experienced significant problems with the apparel orders placed with the Perine Defendants. Bedford routinely accepted the goods on a conditional basis, paying fully for them with a full reservation of rights to charge back Perine due to its failure to abide by the terms of Bedford's purchase orders.

26. The problems with the Perine Defendants continued as Bedford placed additional and larger orders. The Perine Defendants began a consistent pattern and practice of not complying with the terms of Bedford's purchase orders and production specifications, producing goods that arrived late, and/or were defective, nonconforming, mis-sized, and improperly packaged. Bedford reluctantly accepted such goods conditionally, upon the granting of certain charge backs and being able to pay Perine as the goods were sold.

11. Awarding Counterclaim Plaintiffs such other and further relief as the Court deems just and proper.

Dated: New York, New York
March 28, 2013

OLSHAN FROME WOLOSKY LLP

By: 

Lori Marks-Esterman
Martin J. Feinberg
Olshan Frome Wolosky LLP
Park Avenue Tower
65 East 55th Street
New York, New York 10022
(212) 451-2300
(212) 451-2222 (fax)
*Attorneys for Bedford Clothiers, Inc.,
Seena International Inc., Ricky Singh, and
Brooklyn Xpress and Vasu Kothapally*

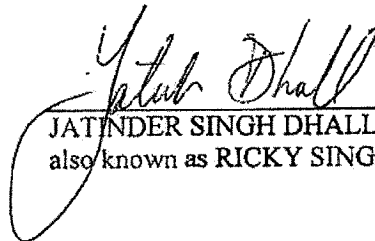
TO: Meister Seelig & Fein LLP
2 Grand Central Tower
140 East 45th Street, 19th Floor
New York, New York 10017
(212) 655-3500
Attorneys for Plaintiff

VERIFICATION

STATE OF NEW YORK)
) ss.
COUNTY OF NEW YORK)

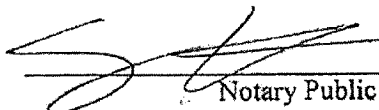
JATINDER SINGH DHALL also known as RICKY SINGH, being duly sworn, deposes and states:

I am a Defendant in the above-captioned cause of action. I have read Defendants' AMENDED VERIFIED ANSWER WITH COUNTERCLAIMS AND CROSS-CLAIMS and, on behalf of all Defendants, declare the same to be true and correct to the best of my knowledge and belief.



JATINDER SINGH DHALL
also known as RICKY SINGH

Sworn to before me this
28th day of March 2013



Notary Public



3/28/13

EXHIBIT C

SUPREME COURT OF THE STATE OF NEW YORK
COUNTY OF NEW YORK

PERINE INTERNATIONAL INC.,

Plaintiff,

- against -

BEDFORD CLOTHIERS, INC., SEENA
INTERNATIONAL INC., RICKY SINGH,
BROOKLYN XPRESS, and VASU
KOTHAPALLY,

Defendants,

-against-

REGENT ALLIANCE LTD., J & COMPANY
JEANS LLC, and NA LAM, also known as LINNA or
LLINNA LAM, LINNA TEXTILES MANUFACTURING
LTD. and VARIOUS JOHN DOES AND JANE DOES,

Additional Cross-Claim Defendants.

Index No. 650040/12

Assigned to
Hon. Barbara
R. Kapnick J.S.C.

IAS Part 39

**AMENDED VERIFIED
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COUNTERCLAIMS AND
CROSS-CLAIMS**

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INTRODUCTION

22. Seena is engaged in the design, manufacture, distribution and sale of high quality apparel items, which are sold primarily in mid-tier department stores and discount retailers throughout the United States, Canada and Europe. Since at least as early as October 31, 2005, Seena has designed, manufactured and sold apparel products bearing the DITCH PLAINS word mark; and since at least 2010, Seena has also designed, manufactured and sold apparel products bearing the DITCH PLAINS logo. These DITCH PLAINS trademarks are well known to the consuming public and trade.

23. Bedford, acting as Seena's design and production arm, is engaged in the design, manufacture and distribution of the high quality apparel items requested by Seena bearing the DITCH PLAINS word mark, DITCH PLAINS logo and other trademarks and designs owned by Seena.

24. Defendant Lam and her husband, Moe Cohen, are the principals of Plaintiff Perine, and Cross-Claim Defendants Regent, J & Co. and Linna Textiles. The Perine Parties operate companies out of Hong Kong who work with brands in the U.S. to have their apparel goods made in China.

25. From December 2010 through December 2011, Bedford contracted with the Perine Parties for the manufacture of Seena's apparel goods. From the very outset, Bedford experienced significant problems with the apparel orders placed with the Perine Parties. Bedford routinely accepted the goods on a conditional basis, paying fully for them with a full reservation of rights to charge back Perine due to its failure to abide by the terms of Bedford's purchase orders.

8. Awarding Seena punitive damages on its claims under New York law.
9. Awarding Counterclaim Plaintiffs their costs and reasonable attorneys' and investigatory fees, together with pre-judgment interest.
10. Directing that this Court retain jurisdiction of this action for the purpose of enabling Counterclaim Plaintiffs to apply to the Court at any time for such further orders and interpretation or execution of any order entered in this action for the modification of any such order, for the enforcement or compliance therewith and for the punishment of any violations thereof.
11. Awarding Counterclaim Plaintiffs such other and further relief as the Court deems just and proper.

Dated: New York, New York
April 27, 2013

OLSHAN FROME WOLOSKY LLP

By: 

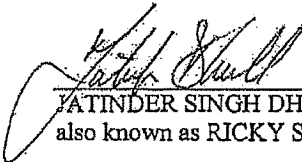
Lori Marks-Esterman
Martin J. Feinberg
Olshan Frome Wolosky LLP
Park Avenue Tower
65 East 55th Street
New York, New York 10022
(212) 451-2300
(212) 451-2222 (fax)
*Attorneys for Bedford Clothiers, Inc.,
Seena International Inc., Ricky Singh, and
Brooklyn Xpress and Vasu Kothapally*

VERIFICATION

STATE OF NEW YORK)
) ss.
COUNTY OF NEW YORK)

JATINDER SINGH DHALL also known as RICKY SINGH, being duly sworn, deposes
and states:

I am a Defendant in the above-captioned cause of action. I have read Defendants'
AMENDED VERIFIED ANSWER WITH COUNTERCLAIMS AND CROSS-CLAIMS and,
on behalf of all Defendants, declare the same to be true and correct to the best of my knowledge
and belief.



JATINDER SINGH DHALL
also known as RICKY SINGH

Sworn to before me this
29 day of April 2013



Notary Public

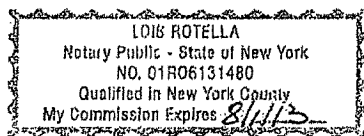


EXHIBIT D



EXHIBIT E

**THIS OPINION
IS NOT A PRECEDENT OF
THE TTAB**

Mailed: July 7, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Seena International Inc.

Serial No. 76694609

Ira J. Levy and Jessica L. Rothstein of Goodwin Procter for
Seena International Inc.

Meghan M Reinhart, Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).¹

Before Walters, Bucher and Bergsman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Seena International Inc. has filed an application to
register the standard character mark DITCH PLAINS on the
Principal Register for "mens and womens clothing, namely,
suits, trousers, jackets, blouses, pants, dresses, shirts,
shorts, board shorts, underwear, jeans, T-shirts, hats,

¹ Although Ms. Reinhart is listed in the USPTO records as the Trademark
Examining Attorney of record, we note that the office actions and brief
were prepared by two other trademark examining attorneys.

vests, sweatshirts, ties, tank tops, coats, hats (sic) and swim trunks," in International Class 25.²

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the typed mark DITCH PLAINS, previously registered for "oyster bar, restaurant and bar services," in International Class 43,³ that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65

² Serial No. 76694609, filed December 3, 2008, based on first use and use in commerce as of July 17, 2007.

³ Registration No. 3327160, issued October 30, 2007, to West Broadway Management LLC.

USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The Marks

We turn our consideration, first, to the marks and draw the obvious conclusion that applicant's mark and the registered mark are identical in terms of appearance, sound, connotation and commercial impression.

This *du Pont* factor weighs strongly against registrability.

The Goods/Services

We thus begin our analysis of the respective goods and services with the premise that, because the marks at issue are identical, the extent to which the applicant's goods and registrant's services must be similar or related to support a finding of likelihood of confusion is lessened. See *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). It is only necessary that there be a viable relationship between the

two to support a finding of likelihood of confusion. *See In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

The question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). *See also, Octocom Systems, Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Further, it is a general rule that goods and services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods and services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods and services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited

therein; and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

The examining attorney contends that applicant's clothing items are closely related and complementary to registrant's restaurant services. She submitted excerpts from several restaurant websites that include T-shirts and other clothing items bearing the restaurant name for sale through the website; and copies of third-party registrations that include both clothing items and restaurant services in the identification of goods. The following are several representative examples from the record:

- A registration for the mark TOMMY BAHAMA'S BAR AND GRILLE for restaurant services; an excerpt from the Tommy Bahama website referencing Tommy Bahama clothing and cafes; and an excerpt from www.opentable.com reviewing Tommy Bahama's Island Bar and Grille.
- An excerpt from www.Margaritaville.com showing use of the mark JIMMY BUFFET'S MARGARITAVILLE in connection with both restaurant services and various items of clothing.
- An excerpt from www.PlanetHollywood.com showing use of the mark PLANET HOLLYWOOD in connection with both restaurant services and clothing; and a registration owned by Planet Hollywood for the mark PLANET DAILIES for restaurant services and various items of clothing.

- An excerpt from a website owned by The Blue Monkey Sports Bar showing use of the mark BLUE MONKEY in connection with both restaurant and bar services and clothing; and a registration for BLUE MONKEY for restaurant services and various items of clothing.
- Third-party registrations for the following marks, all of which include in the identifications both restaurant services and clothing: CANCUN LAGOON, HARD ROCK, CAROLINA WINGS, BIG SKY, SANDERS' BARE BUTT BBQ CO., LOOSELEAF SALAD COMPANY, and RAINBOW BAR AND GRILL.

Applicant argues that there is no per se rule that restaurant services and clothing are related; that the evidence in the record is minimal and does not establish such a relationship; and that the sale of clothing by only a few well-known restaurants is merely promotional and, thus, not probative.

Comparing applicant's clothing with registrant's restaurant services, it is obvious that they are distinctly different. However, as indicated above, goods and services need not be identical or even competitive in order to support a finding of likelihood of confusion. In this case, we find the record sufficient to establish that restaurants do sell clothing in connection with their restaurant services. Whether this clothing also serves to promote the restaurant is immaterial. The record contains no evidence

about whether the third-party marks are well-known, but that is also immaterial. Suffice it to say, the evidence from Internet websites and third-party registrations clearly establishes a relationship between restaurants and at least the jackets, shorts, T-shirts, hats, and sweatshirts identified in the application. In this regard, we note that applicant did not submit any evidence to rebut the evidence submitted by the examining attorney or to support its own factual assertions. Because likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application, *see Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981), the USPTO need show only that at least one of the identified goods identified in the application is related to the services of the cited registration.

This *du Pont* factor also weighs against registrability.

Channels of Trade/Class of Purchasers

Neither the identification of goods in the involved application nor the recitation of services in the cited registration is limited to any specific channels of trade or class of purchasers. Clearly, the usual class of purchaser for both the goods and services is the general public. Presumably, the trade channels overlap to the extent, at least, that clothing items are available for sale at

restaurants and through restaurant websites. Thus, these *du Pont* factors also weigh against registrability.

Conclusion

When we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that in view of the identical nature of the marks, their contemporaneous use on the related goods and services involved in this case is likely to cause confusion as to the source or sponsorship of such goods and services.

To the extent that any doubts might exist as to the correctness of our likelihood of confusion conclusion, we resolve such doubts in favor of the registrant. *See Century 21 Real Estate Corp.*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992); *Ava Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783 (TTAB 2006); and *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844 (TTAB 2004).

Decision: The refusal under Section 2(d) of the Act is affirmed.

EXHIBIT F

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2011-1006
(Serial No. 76/694,609)

IN RE SEENA INTERNATIONAL INC.

Appeal from the United States Patent and Trademark Office, Trademark
Trial and Appeal Board.

ORDER

OFFICE OF THE
GENERAL COUNSEL
2010 DEC -7 PM 3:34
U.S. PATENT
AND
TRADEMARK OFFICE

NOTE: This order is nonprecedential.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

ORDER

The parties having so agreed, it is

ORDERED that the proceeding is DISMISSED under Fed. R. App. P. 42 (b).

FOR THE COURT,

Jan Horbaly

Jan Horbaly
Clerk

12/03/10

cc: Clerk's Office, PTO
Ira J. Levy
Raymond T. Chen

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

DEC 03 2010

JAN HORBALY
CLERK

ISSUED AS A MANDATE: 12/03/10

IN RE SEENA INTL, 2011-1006
PTO - 76/694,609

CERTIFIED COPY
I HEREBY CERTIFY THIS DOCUMENT
IS A TRUE AND CORRECT COPY
OF THE ORIGINAL ON FILE.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

By: James Benjamin Date: 12/3/10